

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 40

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte SVEN E. OBERG and DAVID P. MITCHELL

Appeal No. 2002-0225
Application No. 08/332,275

HEARD: June 13, 2002

Before COHEN, STAAB, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 17, 19 to 21, 23, 25, 26 and 30 to 34. Claims 15 and 16, the only other claims pending in this application, have been allowed.

We REVERSE.

BACKGROUND

The appellants' invention relates to a boot having a rigid tread sole and an insole formed of soft, cushioning, light weight, thermal insulating material. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Makovski	3,007,184	Nov. 7, 1961
Desma-Werke GmbH. (Desma-Werke)	GB 1,145,809	Mar. 19, 1969
Vibram S.P.A. (Vibram)	FR 2,034,828 ¹	Dec. 18, 1970

Claims 19 to 21, 23, 25 and 26 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

Claims 17, 19, 21, 25, 26 and 32 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Vibram.

¹ In determining the teachings of Desma-Werke, we will rely on the translation provided by the USPTO. A copy of the translation is attached for the appellants' convenience.

Claims 19 to 21 and 25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Desma-Werke.

Claim 23 stands rejected under 35 U.S.C. § 103 as being unpatentable over Vibram in view of Makovski.

Claims 30, 31, 33 and 34 stand rejected under 35 U.S.C. § 103 as being unpatentable over Vibram.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 34, mailed May 31, 2001) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 33, filed April 23, 2001) and reply brief (Paper No. 36, filed July 23, 2001) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness rejection

We will not sustain the rejection of claims 19 to 21, 23, 25 and 26 under 35 U.S.C. § 112, second paragraph.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented can be determined from the language of the claims with a reasonable degree

of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is inappropriate.

Furthermore, the appellants may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the Court in In re Swinehart, 439 F.2d 210, 213-14, 169 USPQ 226, 228-29 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

With this as background, we analyze the specific rejection under 35 U.S.C. § 112, second paragraph, made by the examiner of the claims on appeal.

The examiner concluded (answer, p. 4) that the phrase "a removable insole" as recited in independent claims 19 and 25 is functional, indefinite and incomplete because it contains functional language not supported by recitation in the claim of sufficient structure to warrant the presence of such language. The examiner further stated that it was not clear what structural limitations the appellants intended to encompass with such language.

We agree with the appellants argument (brief, p. 5) that the phrase "a removable insole" as recited in independent claims 19 and 25 is definite as required by the second paragraph of 35 U.S.C. § 112. In that regard, one skilled in that art would clearly understand the claimed phrase "a removable insole" to mean an insole that is not permanently affixed, such as by epoxy, to the boot's tread sole or upper.

For the reasons set forth above, the decision of the examiner to reject claims 19 to 21, 23, 25 and 26 under 35 U.S.C. § 112, second paragraph, is reversed.²

The anticipation rejection based on Vibram

We will not sustain the rejection of claims 17, 19, 21, 25, 26 and 32 under 35 U.S.C. § 102(b) as being anticipated by Vibram.

To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

² It appears that the phrase "and secured in said cavity" recited in claim 25, paragraph (c), should be deleted since that phrase may conflict with the earlier recitation that the insole is removable.

Claims 17, 19, 21, 25, 26 and 32 are directed to a boot comprising, inter alia, a tread sole; an upper secured to the tread sole; and an insole. Vibram's invention relates to a sole assembly in the manufacture of shoes having segmented uppers such as sandals.

The appellants argue (brief, p. 6; reply brief, p. 2) that claims 17, 19, 21, 25, 26 and 32 are not anticipated by Vibram since Vibram does not disclose a boot. We agree. In that regard, we view the appellants' definition of boot³ (reply brief, p. 2) to be the broadest reasonable meaning of the term boot as used in its ordinary usage as it would be understood by one of ordinary skill in the art taking into account the written description contained in the appellants' specification. Thus, we view the examiner's definition of boot⁴ (answer, p. 7) to be in error.

Since all the limitations of claims 17, 19, 21, 25, 26 and 32 are not disclosed in Vibram for the reasons set forth above, the decision of the examiner to reject claims 17, 19, 21, 25, 26 and 32 under 35 U.S.C. § 102(b) as being anticipated by Vibram is reversed.

³ Any closed shoe with an upper rising higher than the ankle.

⁴ A protective covering for the foot.

The anticipation rejection based on Desma-Werke

We will not sustain the rejection of claims 19 to 21 and 25 under 35 U.S.C. § 102(b) as being anticipated by Desma-Werke.

Claims 19 to 21 and 25 are directed to a boot comprising, inter alia, a tread sole; an upper secured to the tread sole; and a removable insole.

Desma-Werke's invention relates to a boot as shown in Figure 1 having a multi-part sole 12 and an upper 11. The multi-part sole comprises an injection molded layer 13 and an outer sheathing 14. The injection molded layer 13 connects the outer sheathing 14 and the upper 11.

The appellants argue (brief, p. 7; reply brief, p. 3) that claims 19 to 21 and 25 are not anticipated by Desma-Werke since Desma-Werke's does not disclose a removable insole. We agree. In that regard, we view the examiner's interpretation (answer, p. 8) as to how the removable insole is met by Desma-Werke⁵ to be inconsistent with the

⁵ That Desma-Werke's insole (i.e., injection molded layer 13) could be removed if one desired to do so.

meaning of that phrase as it would be understood by one of ordinary skill in the art taking into account the written description contained in the appellants' specification.⁶

For the reasons set forth above, the decision of the examiner to reject claims 19 to 21 and 25 under 35 U.S.C. § 102(b) as being anticipated by Desma-Werke is reversed.

The obviousness rejections

We will not sustain the rejection of claims 23, 30, 31, 33 and 34 under 35 U.S.C. § 103.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

⁶ See our discussion above with respect to the examiner's indefiniteness rejection.

In the two rejections under 35 U.S.C. § 103 before us in this appeal, the examiner determined (answer, pp. 5-6) that it would have been obvious to one having ordinary skill in the art at the time the invention was made to have (1) secured Vibram's insole to the tread sole with an adhesive as taught by Makovski, and (2) made Vibram's insole and tread sole from either PVC, PU or rubber.

However, such modifications to Vibram would not have arrived at the claimed invention since Vibram does not disclose a boot as set forth in our discussion above with respect to the 35 U.S.C. § 102 (b) based on Vibram. Accordingly, a prima facie case of obviousness has not been set forth by the examiner. Therefore, the decision of the examiner to reject claims 23, 30, 31, 33 and 34 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 19 to 21, 23, 25 and 26 under 35 U.S.C. § 112, second paragraph, is reversed; the decision of the examiner to reject claims 17, 19 to 21, 25, 26 and 32 under 35 U.S.C. § 102(b) is reversed; and

the decision of the examiner to reject claims 23, 30, 31, 33 and 34 under 35 U.S.C.

§ 103 is reversed.

REVERSED

IRWIN CHARLES COHEN
Administrative Patent Judge

LAWRENCE J. STAAB
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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